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CHARLES ELMORE GOSLEY
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IN THE
Supreme Court of the United States

OCTOBER TERM, 1941.

No. 332.

THE WILLIAMS MANUFACTURING COMPANY,
Defendant-Petitioner,

v.

UNITED SHOE MACHINERY CORPORATION,
Plaintiff-Respondent.

REPLY BRIEF FOR DEFENDANT-PETITIONER.

H. A. TOULMIN, JR.,
ROWAN A. GREER,
JAMES B. O'DONNELL,
Counsel for Petitioner.

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Matters Not Discussed.

Throughout respondent's brief reference is made to questions of infringement and allied matters. No such questions were presented by the petition for the writ. We understand that such questions cannot now be discussed here and we have not done so. Our silence does not mean that we agree: it only means that we are endeavoring to conform to the off repeated announcement of this rule by this Court.

Crown Cork & Seal Company v. Ferdinand Gulton,
304 U. S. 159-161.

General Pictures Company v. Electric Company, 304 U. S. 175-177-178.

Connecticut v. Palmer, 305 U. S. 493.

National Licorice v. National Labor Relations Board, 309 U. S. 350.

Rorick v. Devon, 307 U. S. 299-303.

The following comments we hope will be helpful in correcting any misapprehensions from certain of the statements in respondent's brief.

Briefly, respondent's brief proposes that the claims in issue are good because the old elements of the old combination are useful, together with the alleged new adjustments. As elsewhere stated, we believe this is true of nearly all of such invalid claims; that the old mechanism included is bound to be useful. There would be no purpose in including what was not useful, but that is no justification for re-monopoly because utility alone does not confer invention.

Error as to the Dragging Back of Leather.

Respondent's brief at page 12, claims "that the objectionable dragging back of the leather takes place before the tacks are driven," and that the depressing of the shoe in the first McFeely patent does not take place until after the tacks are driven. A reference to the first McFeely patent will show that this is not correct. The wipers are retracted either partially or wholly and either once or a number of times before the tacks are driven. Please witness what the specification of the first McFeely patent says on this subject:

"By the use of these devices the machine can be made to repeat its cycle as many times as may be required with the tacking mechanism each time ineffective and thus a particularly stubborn shoe be lasted in by successive operations of the wipers and finally tacked when it is in satisfactory condition." (R. Vol. II, p. 289)

"The raising of the bottom rest and the lifting of the shoe following it by the expansion of the yielding element in the jack lifting mechanism takes place auto-

matically between the two overworking operations of the wipers." (R. Vol. II, p. 290.)

"If the shoe is a difficult one to last the operator may suspend the driving of the tacks that are in the tack blocks and the delivery of a second set of tacks by shifting the hand lever 145 to set the block 140 and the stop 147. The operator will then watch the wiping over operation and if it is satisfactorily done he will withdraw the block and stop and permit the upper to be fastened by the tacks. If it is unsatisfactory the shoe will be subjected to another cycle of the machine's operation and the block and stop will be withdrawn at the proper time to permit the upper to be secured and a set of tacks fed into place to be driven into the next shoe." (R. Vol. II, p. 290)

It would thus seem that a number of wiping operations take place before the tacking, and "the lifting mechanism takes place automatically between the two overworking operations of the wipers."

Hence, defendant's statement that the change in elevation takes place only after tacking is incorrect.

What Respondent Claims to be the Essence of the McFeely Patent in Suit is Wholly Old.

Respondent says (pp. 13-14) that the two things that characterize the McFeely patent in suit are "he so interconnected the tackers and the wipers that the tackers participate in all movement of the wipers." And he combined with these tackers and wipers moving together, a preliminary adjustment of the position of the wipers.

The first McFeely patent shows (Figure 8) that the tackers 120 are inserted through the wipers 70 and 71, and move with the wipers as a unit so "that the tackers participate in all movements of the wipers." See page 6, lines 50-130, page 7 lines 1-25, which describe this movement of wipers and tackers as a unit in the first McFeely patent.

As to the second alleged new feature of combining a preliminary adjustment of the wipers with the combination of tackers and wipers, this likewise is shown in the first Mc-

Feely patent in the same Figure 8, with the adjusting spring 88, sleeve 87 and cam 86. The object of the adjustment in both McFeely patents is to insure that the wipers will only go to a predetermined position and no further. The first McFeely patent describes this operation on page 4, lines 117-130; page 5, lines 1 to 55. It summarizes the operation by saying:

“Normally, however, the wiper will overcome any resistance offered by the work and complete its stroke into predetermined position over the last bottom to wipe the upper into position to be tacked.”

In view of the foregoing quotation and the rest of the description and drawings in the first McFeely patent, we submit that these two features said to be of essence of the second McFeely, are found within the drawings and description of the first McFeely patent. Incidentally, Copeland shows and describes tackers mounted on the wipers and driving the tacks through the wipers precisely like the second McFeely patent, and the movement of the independent bars c-1 with rollers d-3, will preliminarily adjust the wipers with their tackers mounted on them. (See page 2, lines 102-109.)

Respondent's statement at the bottom of page 16 and top of page 17 of its brief that c-1 is merely the frame of the machine is incorrect. There are two of such members independently adjustable of one another and their position determines the point from which the actuation of the wipers and tackers as a unit, will start.

Respondent's contention (page 21) that “a vital part of the mechanism involved in the new combination is an interconnection between the tackers and wipers such that the tackers move with the wipers during the power stroke of the wipers as well as during any preliminary adjustment of the wipers” is completely met by the interconnection of the tackers and wipers moving together during the power stroke in the first McFeely patent. The only difference (optional in this art) is that the first McFeely had its tack-

ers connected to the wipers so that the tacks would be driven along the margin of the wipers and in the second McFeely the tacks were driven through the wipers as taught by the old Copeland patent. In either event "the tackers, at the end of the power stroke of the wipers, are in the proper position with reference to the margin of the wipers to drive their tacks, regardless of the size of the shoe being lasted."

A reading of the first McFeely patent or the Copeland patent will show this to be true because obviously there must be some means to position the tackers so that they will clear the wipers or tack through the wipers and some means of putting the tacks in the edge of the turned over leather according to the size of the shoe. This is so fundamental in all machines of this class from the very beginning that it is elementary.

The Nature of the Claims.

Respondent takes the position that its claims are good because all the elements in the claims are necessary to the complete functioning of the apparatus. But this is not the answer to respondent's problem. For instance, a patent on a carburetor should not include the engine or the automobile in which the engine is mounted, just because the engine and the chassis of the automobile are necessary in getting the result from the carburetor.

It was on this principle that this Court in *Bassick v. Hollingshead*, 298 U. S. 419, invalidated a claim which included a pump, a discharge coupling connected to the pump, a second coupling and various mechanisms for forming a connector to connect the hose to the automobile so that the grease pump could discharge the grease through the conduit. It was quite true that all of these elements of this invalidated claim were necessary to the complete functioning of the apparatus, but that is no excuse for trying to claim all of such elements in combination with the specifically new thing or the alleged improvement. To say that just because all of the elements of a claim are useful in securing an ultimate general result is an excuse for remonop-

olizing the old combination is simply to beg the question of extension of monopoly. That is the very error that the Circuit Court of Appeals fell into in following this same line of argument in this case.

Likewise in *Lincoln v. Stewart-Warner*, 303 U. S. 548, the claim was the combination of a lubricant compressor with a coupling member, a nipple and mechanism actuated through the grease for effecting a clamp of the lubricating apparatus on a portion of an automobile to lubricate it. Here again the same principle was applied that is present in this case. It is no justification for attempting to re-patent an old monopoly to say merely that the elements of the old monopoly are useful in connection with the detailed improvement included in the claim. Of course they are: it would be strange if they were not useful.

The Sliding Heel Band Feature.

Respondent says that in the McFeely patent in suit that "the essential feature of the heel band adjustment mechanism shown in the McFeely patent in suit is that this mechanism is such that the heel band slides with relation to its supports, etc." That was true of the first McFeely patent. The heel band was movable in the rubber cord supports so that it could slide in one direction under the pressure of the shoe and in the other direction under the pressure of the back stop 69 which is exactly the same as in the second McFeely patent except that it is not permanently attached to the back of the heel band. Of this the first McFeely patent said "a back stop 69 is adjustably mounted into position to limit the backward movement of the shoe into the elastic heel band which is effected by the connection to the jack post through the rod 43. This insures a predetermined positioning of the shoe lengthwise with relation to the operating parts of the machine."

And then the patent goes on to say that this back stop is adjustable by the shaft 690 "for different groups of sizes such as men's, women's, children's." That, of course, is the purpose of a slidable heel band—adjustment to differ-

ent sizes of shoes which causes the heel band to be positioned at different points inwardly and outwardly. Such an adjustment is old as note the illustrations in our main brief from Brock 1,188,616 and Keyes 1,023,854.

It is obvious that this must be so and that the statement of the Court of Appeals was not correct when it said that "the heel band of the first McFeely machine was loose and without support and incapable of sliding movement." The very fact that it was loose proves it capable of sliding movement and that it must be supported by the rubber bands or it would be of no use. There would be no point in adjusting the position of the back pressure rod engaging the back of the heel band marked 69 unless there was an in-and-out movement which is slidable as described in the above quotation from the first McFeely patent.

Adjustments of the Vertical Movement of the Hold-Down.

In our main brief we have quoted from the first McFeely patent and the Pym patent and pointed out in each case the parts of the drawings and the description that show that these patents do have this feature. We are content to leave those statements as to those patents to show that this is a fact. See pages 7, 10, 13, 21, 27, etc. of our main brief.

Questions of Fact.

We can assume for the purpose of argument that all the statements and Findings of Fact were correct. While we do not agree that this is so because "clear error is shown" yet even with this assumption petitioner is still on sound ground because it makes no difference if all these facts be true for the good reason that respondent is still in the position of having endeavored to cover a number of admittedly old elements in an old combination by merely including an adjustment which it says is new. It mistook its remedy. It should have claimed such an adjustment per se. So the whole argument as to Findings of Fact can be conveniently disposed of because it does not in the end change the basic

question and the essential ruling heretofore made by this Court that you must not claim more than your invention or you will have committed a fatal error in the drafting of the claims. It is just as much to the public interest to leave the old combination free to the public as it is to the public interest to encourage invention by giving protection to the specifically new thing contributed by the inventor. When such a contribution is made it is no excuse to remonopolize what has already gone to the public domain.

Petitioner Desires No Retrial of the Facts.

The facts are plain and settled: petitioner does seek a proper application of the law *on extension of monopoly*, based upon the facts as found by the Courts below. Petitioner's issue with the Courts below is one solely of law as to the application of the decisions of this Court in *Bassick v. Hollingshead*, 298 U. S. 415; and *Lincoln v. Stewart-Warner*, 303 U. S. 545 and other decisions of this Court.

This is a question, therefore, of a construction of patents, which is a matter of law. *Powder Co. v. Powder Works*, 98 U. S. 126, 134; *Singer v. Cramer*, 192 U. S. 265; *Sanitary Refrigerator v. Winters*, 280 U. S. 30; *Hurin v. Electric Vacuum Cleaner*, 298 F. 76 (C. C. A. 6); *Budd v. Wilson*, 21 F. 2d 803 (C. C. A. 6); *Motor Wheel v. Rubsam*, 92 F. 2d 129, 131 (C. C. A. 6), certiorari denied 304 U. S. 560; *Baldwin Rubber v. Paine & Williams*, 99 F. 2d 1, 3 (C. C. A. 6).

Likewise, what is or is not aggregation, is a construction of a patent and is a matter of law. See cases cited above and *Grinnell v. Johnson*, 247 U. S. 426.

Therefore, in view of the foregoing, it will be seen that respondent is in error in stating that the issue is one of fact: the fundamental issues are those of law.

Respectfully submitted,

H. A. TOULMIN, JR.,

ROWAN A. GREER,

JAMES B. O'DONNELL,

Counsel for Petitioner.